

REMARKS

By the present amendment, claims 1-9 have been deleted and new claims 10-12 have been added. New claim 10 is supported in the application as filed, for example in previous claims 1-3 as well as on page 9, lines 10-11 of the application as filed. New claim 11 is supported in the application as filed, for example on page 9, line 20. New claim 12 is supported in the application as filed, for example on page 10, lines 22-30. New claim 13 is supported in the application as filed, for example on page 12, lines 5-6, page 19, lines 12-20 and SEQ ID NO:19. The amendments to the claims have been made without prejudice and without acquiescing to any of the Examiner's objections. Applicants reserve the right to pursue any of the deleted subject matter in a further divisional, continuation or continuation-in-part application. The amendment does not contain new matter and its entry is respectfully requested.

The Official Action dated February 24, 2003 has been carefully considered. It is believed that the amended claims submitted herewith and the following comments represent a complete response to the Examiner's rejections and place the present application in condition for allowance. Reconsideration is respectfully requested.

Election

Applicants have deleted previous claims 4-9 as being drawn to a non-elected invention.

Specification

As requested by the Examiner, Applicants have amended the title to read "Methods of Treating Cancer By Administering Antibodies to OX-2".

Priority

Applicants have amended the first paragraph of the specification in order to update the status of USSN 09/570,367 which is now U.S. Patent No. 6,338,851. The Examiner comments that the priority documents provide adequate written support for a method of treating cancer but does not support the language used in the present claims. Without agreeing with the Examiner, Applicants have amended the current claims in order to

recite a method of treating cancer rather than a method of preventing, inhibiting or reducing tumor cell growth.

35 USC §112, First Paragraph

(a) Written Description

The Examiner has objected to claims 1-2 under 35 USC §112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

We note the Examiner's comments that Applicants have disclosed antibodies to OX-2 and we also note that claim 3 which relates to antibodies is not included in the objection. Consequently, Applicants have amended the main independent claim in order to define the agent as an antibody that binds to an OX-2 protein. Applicant has also added new dependent claims which are directed to preferred embodiment of the invention.

In view of the foregoing, we respectfully request that the objection to the claims as lacking written description be withdrawn.

(b) Enablement

The Examiner has objected to claims 1-3 under 35 USC §112, first paragraph because the specification, while being enabling for a method of inhibiting or reducing tumor cell growth by administering an antibody to OX-2, does not reasonably provide enablement for: a) a method of preventing tumor cell growth; or b) a method of inhibiting or reducing tumor cell growth by administering any agent that inhibits OX-2.

With respect to "preventing a tumor cell growth", the claims have been amended in order to delete reference to "prevention". With respect to "any agent that inhibits OX-2", as stated above, Applicants have amended the claims in order to specify that the agent is an antibody to OX-2 which the Examiner agrees is enabled by the present specification.

In view of the foregoing, we respectfully request that the objection to the claims as lacking enablement be withdrawn.

35 USC §102

The Examiner has objected to the claims under 35 USC §102(b) as being anticipated by Gorczynski et al. (WO 99/24565) or 35 USC §102(e) as being anticipated by Gorczynski et al. (U.S. Patent No. 6,338,851). Both of the references cited by the Examiner are the parent applications for the present case. We note the Examiner's comment that amendment "of the claims to recite claim language for which there is adequate written support in the priority documents would obviate these rejections". Consequently, in response, Applicants have amended the claims in order to recite a method of treating cancer which finds adequate support in the priority application.

In view of the foregoing, we respectfully request that the objections to the claims under 35 USC §102(b) and 102(e) be withdrawn.

The Commissioner is hereby authorized to charge any fee (including any claim fee) which may be required to our Deposit Account No. 02-2095.

Attached hereto is a marked-up version of the changes made to the figures by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made".

In view of the foregoing comments and amendments, we respectfully submit that the application is in order for allowance and early indication to that effect is respectfully requested. Should the Examiner deem it beneficial to discuss the application in greater

detail, she is kindly requested to contact the undersigned by telephone at (416) 957-1682 at her convenience.

Respectfully submitted,

**Reginald M. Gorczynski and
David Clark**

A handwritten signature in cursive script, appearing to read "M. Gravelle", written over a horizontal line.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Title:

The title has been amended to read:

--Methods of Treating Cancer by Administering Antibodies to OX-2--.

In the Disclosure:

The paragraph beginning at page 1, line 3, has been replaced with the following rewritten paragraph:

--This application is a continuation-in-part of U.S. application serial no. 09/570,367 filed May 5, 1998 (now [allowed] U.S. Patent No. 6,338,851) which is a continuation of PCT/CA98/01038 filed November 6, 1998 (which designated the U.S.) which claims the benefit of U.S. Provisional application serial no. 60/064,764 filed November 7, 1997 (now abandoned). This application also claims benefit of U.S. Provisional application serial no. 60/222,725 filed August 3, 2000 (now pending). All of the prior applications are incorporated herein in their entirety.--

In the Claims:

Claims 1-9 have been deleted and new claims 10-13 have been added as follows:

10. (New) A method of treating cancer comprising administering an effective amount of an antibody that binds an OX-2 protein to a cell or an animal in need thereof.

11. (New) The method according to claim 10 wherein the animal is human.

12. (New) The method according to claim 10 wherein the cancer is selected from the group of cancers consisting of hematopoietic cell cancers, colon cancer, lung cancer, kidney cancer, pancreas cancer, endometrial cancer, thyroid cancer, oral cancer, laryngeal cancer, hepatocellular cancer, bile duct cancer, squamous cell carcinoma, prostate cancer, breast cancer, cervical cancer, colorectal cancer, and melanomas.

13. (New) The method according to claim 10 wherein the antibody binds to a human OX-2 protein.